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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,998	01/28/2002	John K. Donovan	033455-002	3281

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,998

Applicant(s)

DONOVAN, JOHN K.

Examiner

M Huseman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13, 15 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, it is not clear as to who (user or the person creating the reports to be responded to by a user) is selecting the hyperlinks.

In claims 15 and 29, there is no proper antecedent basis for "each reporting user's current report" (emphasis added) nor for "previous report".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8, 9, 12-14, 20, 21, 23, 27, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by IBM Technical Disclosure Bulletin (hereinafter referred to as IBM).

Regarding claims 1 and 20:

Applicant's step of storing information reads on the folders such that each user represents a folder, Applicant's step of receiving reads on the "recipient response" and Applicant's step of determining reads on the last 6 lines of page 2.

Regarding claims 2, 3, 8, 9, 21, 23, 30 and 31:

Applicant's step of transmitting notification reads on sending notifications to a folder originator and/or recipient/reviewer.

Regarding claims 12, 13, 26 and 27:

Applicant's step of providing hyperlinks reads on the inherent hyperlink address (return address) of any electronic mail.

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Regarding claims 14 and 28:

Applicant's step of transmitting requests reads on the content of the folder to which the reviewer/recipient is expected to respond.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM.

While IBM does not specifically disclose a website, the electronic folders are accessed via computers with electronic mail ability, see line 6 of the "Disclosure Text". Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this system in a "web site" environment for access by, for instance, employees who are on business trips and not able to respond due to the inaccessibility of their work computer.

Regarding claims 5 and 25:

While IBM does not specifically disclose multiple languages, giving the choice to users of reading/transmitting information in their own language is old and well known. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for IBM to offer language choices for its many foreign speaking employees employed around the world.

Regarding claim 6:

Applicant's personal identifying information reads on the reviewer/recipient's name.

Regarding claim 7:

Applicant's step of transmitting information to the reporting user reads on the delinquent notifications sent to the reviewer/recipient.

7. Claims 1, 10, 11, 16 - 19, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of IBM.

Regarding claims 1 and 16:

Hogan teaches a system and method for bill delivery and payment over a network such that Applicant's step of entering reads on the subscriber information, column 5, lines 25 – 35, Applicant's step of establishing a record reads on storing the subscriber information in the server computer memory, column 6, lines 51 – 54, Applicant's step of providing a website reads on the web server, Applicant's step of receiving reports reads on the subscriber logging onto the web server to pay bills and Applicant's step of recording receipt of reports reads on "payments..." of web page of figure 4.

While Hogan does not specifically teach the step of determining from the records the identity of subscribers who have failed to make timely reports and transmitting notices identifying visitors who have failed, IBM discloses a delinquency notification system such that upon examining folders, those whose folders have not been worked on within a specific period of time will receive a notification of delinquency. Hogan does disclose that an e-mail is sent when the subscriber has not logged onto the web server to pay a bill that is due. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to extend the teachings of Hogan to include the delinquency notification upon a bill being over-due rather than just indicate, via e-mail, that the bill is imminently due, as the subscriber would have an indication that he is over-due with regard to certain bills and that those bills require attention.

Regarding claims 10 and 22:

While neither Hogan nor IBM teach the step of revoking, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention that the payee of Hogan would cancel their account with the payer, and thus notify the payer of the cancellation, if the payer was habitually delinquent in making payments to the payee as this is an old and well known method for the payee to induce payment.

Regarding claim 11:

Applicant's step of providing an electronic receipt reads on column 12, lines 14 – 15.

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Regarding claim 17:

Applicant's step of identifying and storing reads on the inherency of the server sending e-mails to subscribers who have not logged on to pay a bill, column 5, lines 57 – 61.

Regarding claim 18:

Applicant's step of requesting information and forwarding any information reads on the server requesting the subscriber to enter payment information and the server forwarding that payment information to the proper account holder (checking or credit card) for the payment of a bill.

Regarding claims 15 and 19:

While neither Hogan nor IBM specifically disclose multiple languages, giving the choice to users of reading/transmitting information in their own language is old and well known. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention for Hogan or IBM to offer language choices for its many foreign speaking purchasers of the Hogan software or the IBM employees employed around the world.

Regarding claim 24:

Applicant's reporting form reads on the home page of Hogan.

Regarding claim 29:

Applicant's step of storing and comparing reads on figure 4, "Amount due last bill", "Current ... Charges", Balance remaining" and "Total ... Due".

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watson discloses a bill consolidation system for scheduling recurring payments to payees. ITT Education Services Inc. discloses placing an institute in a reporting mode such that they are required to report periodically in order to keep their loan accreditation. Layson, Jr. and LaDue each teach a portable tracking apparatus for tracking criminal offenders. Brown discloses a monitoring means for collecting data on an individual's compliance regarding health care maintenance.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

M. Huseman

M. Huseman
Examiner
Art Unit 3621

mh
July 15, 2002


JAMES P. TRAMMELL
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